

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	Paul H. Burmeister, Charles L. Euteneuer, Brian J. Brown, Paul J. Fordenbacher, Anthony C. Vrba
Application No.:	09/427291
Filed:	October 26, 1999
For:	IMPROVED TISSUE SUPPORTING DEVICES
Examiner:	Paul Prebilic
Group Art Unit:	3774

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Docket No.: S63.2N-4944-US04

Request for Reconsideration of Patent Term Adjustment, 37 CFR 1.705

The patentee hereby requests reconsideration, under 35 USC 154(d), of the Determination of Patent Term Adjustment (PTA) made by the Director as indicated on the Determination of Patent Term Adjustment under 35 USC 154(b) mailed 11/16/2011, and the Patent Term Extension History record shown in the USPTO PAIR database, copies of which are attached hereto.

The application was filed on 10/29/1999. Except to the extent discussed below patent term extension is calculated under 37 CFR 1.701.

The Determination of Patent Term Adjustment under 35 USC 154(b) mailed 11/16/2011 shows an adjustment of **465** days.

I. Statement of Facts and Calculation

A. Interference Delay

The application was involved in an interference and under suspension three times for consideration of interference. All of these days are eligible for patent term extension. 37 CFR 1.701(a)(1) and (c)(1).

Interference was declared on 02/07/2011 and determined on 08/29/2011. The

office correctly calculates **204** days. 37 CFR 1.701(c)(1)(i).

The first suspension, from 08-08-2001 to 04/24/2002 is incorrectly omitted in the PAIR record. The applicant calculates **260** days. 37 CFR 701(c)(1)(ii).

The second suspension, for the period 07/01/2004 until 03/18/2005 is correctly calculated by the USPTO at **261** days. 37 CFR 701(c)(1)(ii).

The third suspension, mailed 11/01/2006, lasted until the declaration of interference on 02/07/2011. The office calculation incorrectly omits **1560** days. 37 CFR 701(c)(1)(ii).

B. Appeal Delay

The application was also under appeal to the Board of Interferences. The date of the relevant notice of appeal was 01/22/2004. The appeal brief on 04-09-2004. The appeal was decided in the applicant's favor when the examiner conceded the appeal and again suspended prosecution on 07/01/2004. The Office does not count this as a decision by the Board in favor of the applicant on the appeal. This is error for the reasons given below. The number of days improperly omitted pursuant to 37 CFR 1.701(a)(3) and (c)(3) is **162** days.

Total USPTO delay **2447** days

C. Applicant Diligence

The applicant does not believe that it has acted without due diligence within the meaning of former 35 U.S.C. 154(b)(3)(C), except for extensions of time taken. The allowed claims 22-32 and 34 were presented in a preliminary amendment filed with the application, and were not further amended in prosecution. Extensions of time were required for the response filed on 06/03/2003 (74 days) , the notice of appeal filed on 1-22-2004 (65 days) and the appeal brief filed on 04/09/2004 (19 days). The RCE and response filed on 6/23/2003 resulted in a withdrawal of the previously imposed final rejection. Taking this time as lacking diligence the applicant submits that the total applicant delay is **158** days.

USPTO delay minus Applicant delay: **2289** days

Maximum Extension

The extension is subject to a limit of 5 years. Former 35 U.S.C. 154(b)(4). The earliest priority application for this application is application 08//246320, filed 5/19/1994. The normal expiration date for the patent therefore would be 5/19/2014. The maximum period of extension is 5 years. In this case applicant calculates the five years as **1827** days. Since the total of USPTO delay minus applicant delay exceeds 5 years the period of adjustment is limited to **1827** days.

II. Reasons why the Application is Entitled to Appeal Delay Extension.

Where an agency is charged by statute with deciding an issue which has been presented on appeal for decision, the agency cannot impose rules that remove jurisdiction to decide the appeal. *Union Pacific Railroad Co. v. Brotherhood of Locomotive Engineers*, ___ US ___, 130 S.Ct. 584 (2009). Federal courts have recognized the general applicability of this case to other agencies. *See, Adkison v. Commissioner of Internal Revenue*, 592 F. 3d 1050 (9th Cir. 2010); *Marin-Rodriguez v Holder*, 612 F.3d 591 (7th Cir. 2011); *Pruidze v Holder*, 632 F.3d 234 (6th Cir. 2011); *Luna v. Holder*, case Nos. 07-3796-ag, 08-4840-ag (2nd Circuit 2011); *Ortega-Marroquin v. Holder*; Case No: 10-1846 (8th Cir. 2011); *Auburn Regional Medical Center v. Sebelius*, 686 F. Supp. 2d 55 (USDC DC, 2010).

The USPTO is an agency to which general principles of administrative law apply. *Dickinson v Zurko*, 527 U.S. 150 (1999). Therefore the appeal rules of the USPTO, too, must comply with the *Union Pacific* decision.

35 USC §134(a) states:

An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the primary examiner to the Board of Patent Appeals and Interferences, having once paid the fee for such appeal.

35 USC 134(a) provides applicants with a right to appeal upon final or second action to the BPIA. It does not give the Office authority to remove from Board jurisdiction any matter presented by the applicant in the appeal. The Notice of Appeal is the jurisdiction conferring event, and the Applicant's Brief completes the steps required of the applicant to obtain a decision on the appeal. Since the requirements for Board's jurisdiction over an appeal are set by Congress in §134(a), neither the Director nor the Board of Patent Appeals and Interference can contract the Board's jurisdiction to decide cases by declaring the Board's "jurisdiction" does not begin until it receives an Examiner's Answer (as is apparently the intent of 37 CFR §41.35). Under *Union Pacific* the Board's responsibility to issue a decision on an appeal begins with the Notice of Appeal.

The Office allows Examiner's to withdraw grounds of rejection after an appeal

brief has been filed. It has the discretion to do this only to the extent the examiner is delegated authority to decide the appeal in favor of the applicant. The examiner did so here. His decision is a final decision of the Board in favor of the applicant for purposes of 37 CFR 1.704(e).

III. Conclusion

For the reasons given above the applicant submits that the correct amount of patent term adjustment should be **1827** days.

Respectfully submitted,

VIDAS, ARRETT & STEINKRAUS

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/427,291	10/26/1999	PAUL H BURMEISTER	S63.2-4944-US04	2970

490 7590 11/16/2011
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EXAMINER

PREBILIC, PAUL B

ART UNIT

PAPER NUMBER

3774

DATE MAILED: 11/16/2011

Determination of Patent Term Extension under 35 U.S.C. 154 (b)

(application filed after June 7, 1995 but prior to May 29, 2000)

The Patent Term Extension is 465 day(s). Any patent to issue from the above-identified application will include an indication of the 465 day extension on the front page.

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Extension is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (<http://pair.uspto.gov>).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571)-272-7702. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at 1-(888)-786-0101 or (571)-272-4200.

Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

09/427,291	TISSUE SUPPORTING DEVICES	863.2-4944- US04	11-29- 2011::10:27:13
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Patent Term Extensions

Patent Term Extension (PTE) for Application Number: 09/427,291

Explanation Of Calculations

Filing or 371(c) Date:	10-26-1999	USPTO Delay (PTO) Delay (days):	465
USPTO Adjustment (days):	+0	Corrections (APPL) Delay (days):	0
		Total PTE (days):	465

Patent Term Extension History

Date	Contents Description	PTO(Days)	APPL(Days)
11-16-2011	Mail Notice of Allowance		
11-10-2011	Document Verification		
11-10-2011	Notice of Allowance Data Verification Completed		
11-08-2011	Case Docketed to Examiner in GAU		
11-08-2011	Examiner's Amendment Communication		
01-14-2011	Information Disclosure Statement considered		
11-07-2011	Interference dispatch to TC		
08-29-2011	Mail Interference Decision - Favorable		
08-29-2011	Interference Decision on Priority - Favorable	204	
02-07-2011	Declaration of Interference		
01-14-2011	Electronic Information Disclosure Statement		
01-14-2011	Information Disclosure Statement (IDS) Filed		
12-20-2010	Mail Miscellaneous Communication to Applicant		
12-17-2010	Miscellaneous Communication to Applicant - No Action Count		
09-17-2010	Information Disclosure Statement considered		
09-17-2010	Miscellaneous Incoming Letter		
09-17-2010	Electronic Information Disclosure Statement		
09-17-2010	Information Disclosure Statement (IDS) Filed		
06-16-2008	Mail Miscellaneous Communication to Applicant		
04-01-2008	Miscellaneous Incoming Letter		
02-12-2008	Miscellaneous Incoming Letter		
12-26-2007	Miscellaneous Incoming Letter		
11-16-2007	Miscellaneous Incoming Letter		
09-21-2007	Miscellaneous Incoming Letter		
08-21-2007	Miscellaneous Incoming Letter		
07-20-2007	Miscellaneous Incoming Letter		
06-18-2007	Miscellaneous Incoming Letter		
04-11-2007	Miscellaneous Incoming Letter		
03-07-2007	Miscellaneous Incoming Letter		
02-05-2007	Miscellaneous Incoming Letter		
10-17-2006	Miscellaneous Incoming Letter		

06-12-2008	Miscellaneous Communication to Applicant - No Action Count	
08-08-2007	Information Disclosure Statement considered	
10-12-2007	Case Docketed to Examiner in GAU	
08-08-2007	Information Disclosure Statement (IDS) Filed	
08-08-2007	Information Disclosure Statement (IDS) Filed	
07-12-2007	Correspondence Address Change	
07-13-2007	Change in Power of Attorney (May Include Associate POA)	
11-07-2006	Interference Initial Memo Disposal	
11-06-2006	Mail Miscellaneous Communication to Applicant	
11-03-2006	Miscellaneous Communication to Applicant - No Action Count	
11-01-2006	Mail Letter of Suspension	
10-30-2006	Suspension - Examiner Initiated	
08-28-2006	Mail-Petition Decision - Granted	
08-29-2005	Petition Entered	
07-20-2006	Miscellaneous Incoming Letter	
04-17-2006	Miscellaneous Incoming Letter	
09-08-2005	Date Forwarded to Examiner	
08-29-2005	Response after Non-Final Action	
08-29-2005	Request for Extension of Time - Granted	
06-27-2005	Information Disclosure Statement (IDS) Filed	
06-27-2005	Information Disclosure Statement (IDS) Filed	
06-24-2005	Reference capture on IDS	
06-24-2005	Information Disclosure Statement (IDS) Filed	
06-24-2005	Information Disclosure Statement (IDS) Filed	
04-25-2005	Reference capture on IDS	
04-25-2005	Information Disclosure Statement (IDS) Filed	
04-25-2005	Information Disclosure Statement (IDS) Filed	
03-28-2005	Mail Non-Final Rejection	
03-24-2005	Non-Final Rejection	
03-23-2005	Mail Miscellaneous Communication to Applicant	
03-18-2005	Miscellaneous Communication to Applicant - No Action Count	261
01-13-2005	Miscellaneous Incoming Letter	⌘
01-21-2005	IFW TSS Processing by Tech Center Complete	⌘
11-20-2002	Reference capture on IDS	⌘
04-10-2000	Reference capture on IDS	⌘
01-08-2005	Date Forwarded to Examiner	⌘
01-08-2005	to Close the A/R Record and Reset the Status for Expired Suspensions.	⌘
07-02-2004	Mail Suspension Due to Interference in Another Application	⌘
07-01-2004	Suspension - Interference in Another Case	⌘

04-27-2004	Date Forwarded to Examiner
04-09-2004	Appeal Brief Filed
04-09-2004	Request for Extension of Time - Granted
04-06-2004	Mail Advisory Action (PTOL - 303)
04-05-2004	Advisory Action (PTOL-303)
01-22-2004	Notice of Appeal Filed
02-03-2004	Date Forwarded to Examiner
01-22-2004	Response after Non-Final Action
01-22-2004	Request for Extension of Time - Granted
08-19-2003	Mail Non-Final Rejection
08-15-2003	Non-Final Rejection
06-12-2003	Date Forwarded to Examiner
06-12-2003	Date Forwarded to Examiner
06-03-2003	Request for Continued Examination (RCE)
06-12-2003	Disposal for a RCE / CPA / R129
06-03-2003	Request for Extension of Time - Granted
06-03-2003	Workflow - Request for RCE - Begin
02-12-2003	Notice of Appeal Filed
12-04-2002	Mail Final Rejection (PTOL - 326)
12-04-2002	Final Rejection
11-20-2002	Information Disclosure Statement (IDS) Filed
11-20-2002	Information Disclosure Statement (IDS) Filed
11-27-2002	Date Forwarded to Examiner
11-27-2002	Date Forwarded to Examiner
11-20-2002	Request for Continued Examination (RCE)
11-27-2002	Disposal for a RCE / CPA / R129
11-20-2002	Workflow - Request for RCE - Begin
09-17-2002	Mail Final Rejection (PTOL - 326)
09-16-2002	Final Rejection
07-18-2002	Date Forwarded to Examiner
07-12-2002	Response after Non-Final Action
04-26-2002	Mail Non-Final Rejection
04-24-2002	Non-Final Rejection
08-08-2001	Mail Letter of Suspension
08-08-2001	Suspension - Examiner Initiated
03-05-2001	Power to Make Copies and/or Inspect
04-10-2000	Information Disclosure Statement (IDS) Filed
04-10-2000	Information Disclosure Statement (IDS) Filed
10-26-1999	Preliminary Amendment
02-07-2000	Case Docketed to Examiner in GAU
11-23-1999	Application Dispatched from OIPE

11-17-1999

IFW Scan & PACR Auto Security Review

10-29-1999

Initial Exam Team nn

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